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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/184,418	11/02/1998	BEATRICE H. HAHN	3532-4000	4219

7590 12/03/2001
Benjamin Adler
c/o McGregor & Adler LLP
8011 Candle Lane
Houston, TX 77071

EXAMINER	
ZEMAN, ROBERT	
ART UNIT	PAPER NUMBER

1645
DATE MAILED: 12/03/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/184,418

Applicant(s)

HAHN ET AL.

Examiner

Robert A Zeman

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-41 is/are pending in the application.
- 4a) Of the above claim(s) 7-9, 11-13, 15-32 and 35-41 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 6, 33 and 34 is/are allowed.
- 6) ☒ Claim(s) 10 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-4 and 6-41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The amendment and response filed on 9-20-2001 is acknowledged. Claims 1-4, 6, 10 and 33 have been amended. Claim 5 has been canceled. Claims 1-4, 6, 10, 14, and 33-34 are currently under examination.

Claim Objections Withdrawn

The objection to claim 3 for containing an obvious grammatical error is withdrawn in light of the amendment thereto.

The objection to claims 1-6, 10, 14 and 33-34 for reciting non-elected material is withdrawn in light of the amendment thereto.

Claim Rejections Withdrawn

The rejection of claims 1 and 5 for referring to a figure is withdrawn in light of the amendment to claim 1 and the cancellation of claim 5.

The rejection of claims 2-3 and 5 for being rendered vague and indefinite by the use of the term "derived" is withdrawn in light of the amendment to claims 2-3 and the cancellation of claim 5.

Claim Rejections Maintained

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of claims 10 and 14 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention is maintained for reasons of record.

Applicant argues:

1. Physiologically acceptable carriers are well known in the art.
2. One of ordinary skill in the art would readily know how to make and use a physiologically acceptable carrier to generate the composition claimed.

As outlined in the previous Office action, the aforementioned claims are drawn to pharmaceutical compositions. The specification, however, is silent on how such a composition would be used and equally silent on the **efficacy** of said compositions. People of skill in the art require documented factual evidence that a benefit can be derived by the therapeutic application of a substance. The instant specification fails to provide evidence that the claimed **pharmaceutical compositions would elicit any type of beneficial therapeutic response** since no evidence has been provided that illustrates or even suggests that the claimed pharmaceutical compositions are capable of eliciting a beneficial therapeutic response. While one would know how to **make** the composition, one of skill in the art has not been taught how to **use** the claimed **composition** as a pharmaceutical, as is required by the claims.

Conclusion

Claims 1-4, 6 and 33-44 are allowed.

Claims 10 and 14 are rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

This application contains claims 7-9, 11-13, 15-32 and 35-41 drawn to an invention nonelected with traverse in Paper No. 12. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A Zeman whose telephone number is (703) 308-7991.

The examiner can normally be reached on M-Th 7:30 am - 5:00 pm and Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donna Wortman can be reached on (703) 308-1032. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



DONNA WORTMAN
PRIMARY EXAMINER

Robert A. Zeman
November 27, 2001